

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

In re Patent Application of
MARK JAMES BECKMAN

Serial No.: 09/301,868

Filed 04/29/1999

For: SNACK PACKAGE ADAPTER FOR A BOTTLE

ART UNIT 1761

Docket PA1.640

I hereby certify that this
correspondence is being
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TRADEMARK OFFICE
BY ELECTRONIC MEANS

/John E. Halamka/

John E. Halamka

Dated:

Palos Verdes Estates, CA

Examiner: THAKUR, Viren A.

RESPONSE TO Office Action dated 04/03/2007 NON-FINAL
Rejection responsive to communication filed 19 February 2007.

Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

A similar response to office action dated 03/05/07 for application
serial no. 11044811, the PARANT of this CIP, is being filed. The
arguments and issues are similar.

But as stated below, applicant's attorney is attempting to find a
solution to the co-pending of the ORIGINAL application (09/301,868) and
the CIP based on the original application (11/044,811) to avoid double
patenting. However, until a solution is implemented, applicant's attorney
is responding to the outstanding office actions of both applications to
avoid abandonment of either of the outstanding applications without the
intent of obtaining two separate issued patents and respectfully requests
the examiner to assist applicant's attorney in this effort which is now
extending over eight (8) years which is the major source of applicant's
attorney's confusion regarding these files. This is an attempt to achieve
a means to consolidate the applications for the benefit of applicant's
attorney as well as the examiner.

The cover letter for the office action lists the Attorney Docket No as BECKMA.M-1. Please note this is the docket of Gene Scott, who originally filed the application for applicant BECKMAN. The record should reflect my docket number of PA1640. I am pleased that you have addressed the office action to me but I am still not listed the USPTO records as the attorney of record for this application even though I have submitted a request to be substituted as attorney of record, with the attorney of a power of attorney at least 3 times. Mr. Gene Scott is still listed as attorney of record having the mailing address of P.O. Box 207. THIS ADDRESS belongs to me and is correct. Please correct the name of the attorney of record for this application to be John E. Halamka at your earliest opportunity.

The cover letter lists claims 10-17 as pending however, Paragraph 1 of this office action has reinstated claims 1-9. Therefore the claims pending are 1-17 and this office action is responsive to this set of outstanding claims.

The newly reinstated claims 1-9 have been in “hibernation” since the response to the election/restriction was filed on 18 April 2000. Thus, claims 1-9 have not been exposed for review, modification, or comment that is included in the history of claims 10-17. Further, as claims 1-9 were not part of the PARANT application, the CIP did not include claims 1-9, thus the dilemma.

Applicant’s attorney would like to thank the examiner for reinstating claims 1-9 and thus opening this application to a system engineering type analysis of the total environment in which the application was generated as well as the environment in which the applications have been examined to date.

As a CIP usually includes the claims of the parent application, would a solution to the “double patenting” be the addition of claims 1-9 to the CIP without violation of the new matter rule” or could the original application be limited to claims 1-9 and the CIP which has the equivalent of claims 10-17 be allowed to proceed for examination without violation of the double patenting rule?

This response attempts to include the exposure of claims 1-9 to the environment in which claims 10-17 matured during the almost seven (7) years from restriction to reinstatement. Should the examiner not agree with the analysis applicant’s attorney requests contact at examiner’s earliest opportunity to resolve any further issues the examiner believes need discussion.

Attachment 1 describes the environment in which the inventor worked to better understand how the inventor perceived a need and how the inventor set out to meet this newly perceived need. The invention was codified in an application originally filed by Gene Scott on 5 May 1999. The prior art, as set forth by the examiner, has many examples of combining items, one of which includes a bottle. However, none include combining in the environment of a vending machine whereby the combination results in the ability to INCREASE the price point for the combination, a NEW AND INVENTIVE STEP UNANTICIPATED BY THE PRIOR ART.

In Attachment A, Claims 1-9 of that application are set out and mapped with reference to supporting matter in the original specification and drawing to emphasize what elements are claimed in the invention.

The office action dated 07/05/00 by examiner MAI objected to the language in the claims including the terms “adapted” and “enable”:

The response to the office action dated 07/05/00 attempted to utilize words acceptable to the examiner in place of the words listed. In addition, applicant’s attorney identified the response as being filed by a NEW office, supported with a power of attorney.

The examiner found that the proposed new words added new matter to the application. However, the examiner failed to take notice of the new attorney and mailed the response to the original attorney. This action by the examiner resulted in the abandonment of the application as the original attorney did not receive the next office action and the new attorney could not access the file as the original attorney was listed as attorney of record AND STILL IS.

After a long series of petitions, the abandoned “original” application filed by Mr. Scott was reinstated and is the subject of this office action.

In response to the new matter objection, applicant filed a continuation in part which is cited in this office action as art which would preclude this application under the “double patenting” restriction. Applicant’s attorney is speculating that the original application filed by Mr. Scott was not abandoned as requested on the filing of the CIP because the USPTO did not recognize John E. Halamka as the attorney of record for the “original” filing. Thus, the present situation of having the PARANT and the CIP co-pending was created without any fault of applicant or any intention of applicant’s attorney to attempt the dreaded DOUBLE PATENTENING. Applicant’s attorney seeks assistance to resolve the situation without loss of any rights of applicant.

Attachment A maps the original claims 1-9 as this office postulates are now pending as REINSTATED without applying:

- A. The Non-Final Rejection dated 3 July 2000;
- B. Changes to the application requested in the response to Non-Final Rejection dated 5 January 2000 filed by this office along with notice of substitution of this office as NEW attorney of record supported by a power of attorney.
- C. Final rejection dated 26 March 2001 “miss-mailed” to Gene Scott, who never received it, resulting in abandonment and a series of petitions to revive. Notice of abandonment being issued 1 November 2006 and a continuation in part application serial number 11044811 BEING FILED WITHOUT CLAIMS 1-9 therefore claims 1-9 are presented in a condition as if they would have been include in the CIP and are respectfully requested to be examined.

Again, applicant’s attorney desires to combine the original application 09/301,868 and the CIP based upon the original application 11/044,811 to avoid DOUBLE PATENTENING. Applicant’s attorney will research the procedure under 35 U.S.C. 121 and MPEP section 804.01. Should applicant’s attorney not be successful in solving this situation, any recommendations by the examiner would be deeply appreciated.

The office action dated 04/03/2007 has rejected claim 1-17. The office action in paragraphs 2, 3, 4 and 6 combined with paragraph 5 clarification of the rejection based on Selz also states that the prior arguments against the prior art are moot in view of the new grounds for rejection. However, the new grounds include the prior art previously respectfully traversed by Applicant’s Attorney. Therefore, Applicant’s Attorney repeats the arguments regarding the rejections of claims over Selz (US4693410, Barnes et al. (US5674546), Rea et al. (US5950912), and LaBarbera et al. (US 4170316) individually and in combination as in light of the current submission and respectfully requests the examiner to reconsider the prior arguments.

In Paragraph 7 of the office action, the Examiner has objected to the drawings as failing to reference the description as set forth on Page 8, line 26 of the AMENDED specification recites “snack package 20” in figures 7 and 8 but such figures lack such an item. Applicant’s attorney INCORRECTLY amended the specification in his response dated 5 January 2001 to office action dated 7/5/00. The prior request to insert “20” after snack package on page 8 of the original specification in TWO places on line 26 was incorrect AND IS HEREBY WITHDRAWN. The usage by the writer of the specification, Mr. Scott, of the item “snack package” was to distinguish the prior discussion of an off the shelf snack package (20) being wrapped around or over the neck of the bottle (10) as

differentiated from the present discussion on page 8 line 25 which introduces the ALTERNATE EMBODIMENT of combining the prior snack package (20) and envelope (30) into a envelope (50). Therefore no corrections are required to be made to the drawing as figures 7 & 8 do not have the snack package (20) of the NON-ALTERNATE EMBODIEMENT but correctly show the item (50) as a specially fabricated envelope containing a snack food item. Therefore, applicant's attorney respectfully withdraws the prior request to insert "(20)" after --snack package-- on page 8, line 25.

The response dated 7/5/00 also requested that on Page 8, line 27, after "envelope" insert --30--. THIS REQUEST is modified to insert --50-- as the proper number of the item.

The examiner has determined that the amendment filed January 5, 2001 introduces new matter by adding in claim 14 a limitation of "a catch mounted on the inner wall". Examiner points out that the specification provides support for the inner wall of the snack envelope catching under a neck ridge of the bottle there is and contends that there is no support for a catch on the inner wall of the snack envelope.

This history goes back to the objection of the word "enablement" in the original claim 14 and the attempt by the new attorney to clarify "enablement of the inner wall for engagement with the bottle neck is an inwardly radically directed protuberance". Mr. Scott used the word "enablement" as an element. This "element" is supported in the original specification on page 9, lines 8 -13, and shown in Fig. 7 as item number 58 depicted as a protuberance to catch under the ridge 18 which is an element on most commercial bottles. Thus the REDISCRPTION of the item as being a CATCH is well supported by the language of the original specification and is not new matter. The specification page 9 line 8 places the "engagement" item on the inner wall 56. Thus the placement of the "catch" on the INNER WALL is well supported by the original specification and is not new matter. Applicant's attorney respectfully requests examiner to withdraw his finding of new matter as all of the elements are in the original specification which applicant's attorney used to clarify the language of "engagement".

In paragraphs 9 and 10 of the office action the examiner has rejected claims 10-17 as failing to comply with the enablement requirement. The explanation set out in attachment 1 shows the environment in which the invention was conceived while the inventor was maintaining vending machines read in light of the stated objective of the application to add value to the pigeon holes of the vending machines without modifying the size or shape of whatever existing vending machine one has to work with clearly sets limits to the size and shape of

the combination BOTTLE, SNACK PACKAGE and ENVELOPE so that anyone skilled in the art may practice the invention.

The specification states on page 7, lines 16-29 and page 8, lines 1-23, that the snack package and the envelope can be separate items in the inventive combination, the snack package (20) being a preselected off the shelf manufactured item to eliminate the need to be RE-sealed by the person servicing the vending machine. The separate NEW AND INVENTIVE envelope item (30) is simply slipped over the FILLED snack package (20) so as to attach said snack package (20) to the bottle (10). THE "SNACK package" does not have to be refilled nor does the envelope (30) need to be filled with more snack food as a snack food exists in the combination of the snack package (20) and the NEW AND INVENTIVE ENVELOPE (30) as combined with the bottle (10). This it is clear to one skilled in the art how to use the inventive combination of the three items to practice this invention to fill an open pigeon hole in an existing vending machine.

As stated in the specification, page 8, lines 25-29, and page 9, lines 1-17, one skilled in the art may also combine the snack package and envelope into one item specially manufactured in order to simplify the practice of this invention but this adds cost and special handling to the practice of the invention. Such addition of cost or simplification of attaching the three items in combination should not preclude the finding of inventive matter in the application as the inventive result of allowing the price point for the combination of drink and snack required to be paid by a consumer to be increased in order to open the pigeon hole in the vending machine and obtain the vending of the inventive combination of a snack and a drink to compensate for this method of practicing the invention.

Again, the separate item nominated as a snack package being off the shelf has an inner wall and an outer wall within which to hold snack food and the ends of said snack package are sealed to hold the snack within said package. All limitations are chosen by the OFF THE SHELF snack food PRODUCER. The applicant herein is NOT inventing a snack food package in the first embodiment of combining a snack food (20) with an envelope (30). THIS IS THE SUBJECT of the alternative embodiment shown as item (50). The ENVELOPE (30), a separate item from the snack food package (20) or snack food envelope (30), has an inner wall and an outer wall to contain the snack package and the bottle. The ENVELOPE (30) is not sealed before being assembled to the snack package (20) and bottle (10). The ENVELOPE (30) is by definition capable of receiving A SNACK FOOD in the form of (for example) a pre-packaged, off-the-shelf M&M packet of snack food therefore need not be filled with a snack food AGAIN in order to practice this invention as the snack food is IN THERE.

Thus, applicant's attorney respectfully traverses the examiner's opinion that the claims should not be allowed because they fail to show enablement of being able to shove some snack into the ENVELOPE (30) as "IT'S ALLREADY IN THERE".

Page 6 of the office action, second paragraph, the examiner points out that in claim 13 the language "without releasing said snack food from said envelope" lacks enablement. The examiner finds support for the spiral score but objects to the language teaching that the spiral score is to be removed as being unsupported. The original specification, on page 9, lines 15 to 17, sets forth a reference to Fig. 7, and describes how the opening by means of peeling the envelope along the scored line (not peeling the scored line away from the envelope) allows the user to access the snack food (a separate item) within the NEW and INVENTIVE envelope (30) (a separate item) in one embodiment or as shown in an alternative embodiment as a specially manufactured container (50) filled with a snack food rather than the practice of obtaining an off the shelf snack food package (20). Figure 7 expressly shows the user in the state of peeling the ENVELOPE (50) along the scored line access means (59) in a manner so as to not spill the snack food (22). Thus, applicant's attorney respectfully traverses the examiner's opinion that opening of the envelope (50) along the scored line (59) is not supported. (Of course, the old joke about having the instructions of how to use the scored line (59) written on the bottom of the bottle would certainly result in spilling of the snack food (22) from within the cavity (52) of the ENVELOPE (50). The user is presumed to be reasonable as suggested by the Court in KSR.

Said Court in KSR also requires reasonableness in reading of the patent application and applying combinations in hind sight to the inventive nature of the stated practice of the invention. The use of hard candy as suggested by the examiner certainly constitute a snack food item but a hard candy such as a peppermint stick in the shape of a cane certainly could be attempted but it would be unreasonable to attempt to jam a peppermint stick into a pigeon hole of a vending machine without making peppermint dust. So no one skilled in the art would reasonable consider such an approach not adding value to the combination even if used with a scored envelope.

In addressing examiner's last paragraph on page 5 of the office action, Applicant's attorney respectfully requests the examiner to review the "Regarding the vending of the product Applicant's arguments ..." in light of the comments contained herein.

It is the TYPE (CHOSEN BY THE PRACTITIONER OF THIS INVENTION) of vending machine that guides all of the choices as to type of snack food container to be used in the practice of this invention.

Therefore, to the skilled artisan, the snack food, be it in a separate envelope, the NEW AND INVENTIVE ENVELOPE (30), be it scored or a specially manufactured snack food container having a scored opening may all considered and fabricated for use so as to not have an uncontrolled release of the snack food. JUST IN CASE THE SNACK FOOD IN THE PREPACKAGED FORM IS RELEASED, THE ENCOMPASING NEW AND INVENTIVE ENVELOPE (30) or (50) WILL PREVENT THE SNACK FOOD FROM BEING RELEASED. (Forth sentence in the last paragraph on page 5 of the office action.) This is precisely how to practice the teaching set forth in this inventive application.

Responsive to paragraph 11 and 12 of the office action as contained in the attached discussion, the vending machines in use at the time of the invention used whatever bottle that a bottler supplied to be placed into an array of pigeon holes, each selectively opened upon the condition of payment of a fee. Most being the old glass bottles having a cylindrical base and a neck (long neck beer was a popular example). The present invention makes use of this diminishing diameter neck as it does not fully occupy the pigeon hole in the vending machine. There exists remaining space for the snack food envelope (20) (being an off the shelf item + ENVELOPE (30) item or a specially manufactured snack filled envelope (50), to be assembled in combination with the bottle (10) (having a diminishing neck as a bottle not having a diminishing neck would already substantially occupy the pigeon hole) so as to add value to the contents of said pigeon hole. THE MORE DIMINISHING the bottle neck, the more choice of snack food sized package that may be utilized.

The examiner asserts that the ability to insert the combined object into the vending machine also depends on the size of the vending machine and the relative size of the object. Applicant's attorney wishes to thank the examiner for this observation. This is precisely what the invention teaches. Take an "OFF-THE-SHELF" vending machine which uses some size bottle (must be a bottle with a diminishing neck, the modern NO NECK bottles leave little room to attach something) and attach an off-the-shelf snack package (after adapting – moving the contents around so that the snack package can be wrapped around the diminishing neck or over the cap with the ends of the snack package dangling around the diminishing neck, THEN SECURE the combination together with an ENVELOPE (30) that has an opening big enough to accept at least the diminished neck of the bottle (10) with the snack package (20) around or over the neck. The elements of the combination (especially the snack package and ENVELOPE) must be carefully chosen so that the combination is capable of being placed into an empty pigeon hole of the vending machine. Here, size always is RELATIVE, as the examiner has so kindly observed. As patents rarely contain actual measurements or dimensions, the language of this patent application is

stated in the abstract, teaching the working with reasonable sized elements which are easily discerned by one skilled in the art of loading a vending machine as conveyed in the limitation that the combination MUST not exceed the size of the PIGEON hole, i.e. the combination must only take up “SUBSTANTIALLY THE SAME SPACE AS THE DRINK BOTTLE ALONE”, or the door will not close on the Off-the-Shelf vending machine. The applicant cannot predict what size vending machine the practitioner of this invention will be using but can teach the “relative size”. As the examiner points out and understands, SIZE COUNTS, and after all, applicant IS NOT inventing the vending machine.

Thus, the limitations of BOTTLE (10), SNACK FOOD PACKAGE (20) AND ENVELOPE (30) are imposed by the vending machine. Clearly, the practice of the invention by one skilled in the art will choose a bottle and snack food package combination to fit within the pigeon hole so as to not leave any pigeon hole droppings. THUS, appropriate metes and bounds are clearly established by applicant and continue to govern/limit as to how intimate the interaction of the elements of the bottle (10), snack food package (20) and ENVELOPE (30), with ALL of their individual WALLS must, coexist within said pigeon hole of the pre-existing vending machine.

The examiner objects to the language in claims 14-17 of the “inwardly radially directed protuberance”. This element is clearly shown in Fig. 7 as item (58) as supported by the original specification page 9, lines 9-11.

Responsive to the first paragraph on page 9 of the office action in which the examiner has considered Applicant’s Attorney’s “CROWBAR” discussion but has not found it to be persuasive. The examiner continues that insertion “also depends on the size of the vending machine and the relative size of the object.” Doesn’t all insertion activity take this into consideration? This is precisely the point of this invention. The applicant is NOT inventing a vending machine. The applicant is NOT including modifying existing vending machines in order to practice this invention. Applicant is not inventing the concept of adding something to a bottle. The applicant is taking the vending machine **AS IS** and then modifying the contents of the pigeon hole normally occupied by a bottle (10) alone; applicant is NOT MODIFYING THE HOLE.

Applicant’s Attorney respectively assists that “the contents of the pigeon hole” with the physical limitation of the “OFF-THE-SHELF” vending machine are clearly limitations and set appropriate metes and bounds for the practice of this invention. As stated elsewhere in this response, the evolution the vending machine and bottle technology continue to place limits on the practice of this invention. The bottlers are

introducing plastic instead of glass containers. The containers are being shaped more like a bull dog instead of a gray hound in that the neck is stubby and thick. THEREBY “SUBSTANTIALLY” all of the space within the pigeon hole is being occupied by the MODERN beverage container leaving little room for a snack food unless the practitioner of this invention is very selective of the bottle (10) and the snack package (20) or specially manufactured envelope (50).

Again – this is the inventive part of this application. In practicing the invention, the practitioner takes the vending machine AS IS as well as the beverage container (10). The creative/inventive action is to combine the snack package (20) and the ENVELOPE (30) with the beverage container (10) within the LIMITS of the operating environment, in other words, SIZE ALWAYS matters on insertion. If this “basic concept” of combining two or more items were held as “PRIOR ART” - nothing could be granted as a patent no matter how it is stated in a claim to insert ELEMENT X into ELEMENT Y all patents would have to be considered to be INVALID? This way of using prior art is not following the teaching of the Court in KSR to be reasonable.

The language of the application is merely accepting reality of physics. Two objects cannot occupy the same time space point. In practicing this invention, the practitioner is within the pigeon hole not out in the environment of the expanding universe and is thus properly limited to have the combination occupy only the pigeon hole of the preexisting vending machine. Applicant’s attorney respectfully requests the examiner to reconsider the arguments and find the language of the claims properly limits the practice of the invention.

Responsive to paragraphs 13 and 14 of the office action, the examiner has formed the belief that the language of claims 1 and 6 recites functional language with terms “for”, “adapted for” and “enabled for” and therefore any device that meets such structure is proper prior art capable of performing the recited intended use. Applicant’s attorney respectfully traverses examiner’s opinion.

The introduction of the claims recite the inventive purpose of forming a combination using a:

1. drink bottle (10) defined in the specification as a bottle utilized in a standard vending machine (Page 6, lines 1-2) having a diameter (Page 6, lines 7-8) and a height (page 6, lines 10-11);
2. snack package (20), and
3. envelope (30), whereby said combination can be used in said standard vending machine without modification to the storage or dispensing apparatus of said machine.

Thus, severe limits are recited in the supporting specification of how the combination must be structured so as to function within a defined size and shape. Therefore, not just any bottle, snack package and envelope will meet the limitations of capable of being vended in a standard vending machine.

As the primary limitation on the combination is this capability of being utilized in a "STANDARD VENDING MACHINE" the prior art that is reasonably proper to be cited by the examiner must include this function. A detailed discussion of each of the prior art items applied by the examiner is contained else where in this response.

The specification as applied to the claims teach utilizing an off-the shelf (OR OUT OF THE VENDING MACHINE) bottle to be combined with an off-the-shelf snack food package such as a bag of peanuts. The specification clearly teaches utilizing said snack package that is flexible and limited in size whereby said snack package can be manipulated to fit around or over said bottle yet not increase the overall diameter and height of said bottle whereby said bottle when combined with said snack package may be placed back into said vending machine. THUS, a snack of a box of MALTED MILK BALLS probably would not be chosen by a practitioner of this invention, nor as discussed above a standard candy cane.

Another KEY item in this invention is the ENVELOPE (30). Not just any ENVELOPE will do. The limitations placed on said envelope by the claim as supported by the specification are that said envelope be:

- A. cylindrical in shape;
 - B. have an aperture for accepting the bottle (10) and the snack package (20), and;
 - C. be fabricated of a rigid, transparent plastic sheet (page 7, lines 25-29, and page 8, lines 1-7),
- whereby said ENVELOPE functions to join said snack package to said bottle and thereafter be capable of being placed into the same space of a vending machine that was previously occupied by said bottle (10) alone.

It is this key element, the envelope (30), that is not taught by any of the prior art cited by the examiner such as BARTON (US 4635291) the snack package just HANGS around the bottle. Applicant's attorney asserts that the placement of a BARTON device into a vending machine will not function as a replacement for the inventive combination and it will result in HANGING UP the vending machine. BARTON has a bottle (10), a package into which anything may be placed, even an eatable snack FOOD (20) but NO ENVELOPE (30) to hold the snack package securely to the bottle. The cited art must have ALL of the elements to be proper prior art. Applicant's attorney respectfully request the examiner

to withdraw BARTON as prior art. Without the ENVELOPE (30) or its equivalent, the hanging snack package (20) may become dislodged from the bottle (10) and hang in the vending machine.

Response to Paragraph 15 of the office action, examiner has rejected claims 10 and 14-17 as being anticipated by Schumacher et al. (US 5465835) because Schumacher discloses a bottle axially joined with a diminished bottle neck and a snack package. The title of the invention is bottle closure cap. Of course, as stated above, size can be of concern. The relative size shown in Fig. 12 of SCHUMACHER of the bottle that is sealed with the Schumacher invention and the snack package space that is inside the bottle cap appears to allow a few pills to be placed into the bottle cap and then consumed with the aid of the contents of the bottle. Or the invention of Schumacher may be used to place an alcoholic beverage within the cap and mixed with the contents of the bottle. Certainly not items one could place in a vending machine accessible by minors.

Schumacher LACKS a bottle (10) and the ENVELOPE (30) of applicant's invention. Schumacher's invention is a hollow bottle cap – part of one item of applicant's three items. The contents of the hollow bottle cap are to be mixed with the contents of the bottle the Schumacher invention caps. This mixing as taught by Schumacher is performed by having the protuberance of the cap (Figure 12, Item 7) puncture a seal to allow the contents of the cap to flow into the bottle. The purpose of the Schumacher invention is to keep the two liquids separate until they are ready to be used. See page 3 lines 5-8 of Schumacher. The contents of the cap appear to be chemical in nature not snack food. Of course, the cap could contain an alcoholic beverage and the cap could restrain orange juice within the lower container. This is certainly not taught but most importantly, the disclosure in Schumacher is far from teaching ALL items taught by applicant, NO ENVELOPE (30). Applicant's attorney respectfully request examiner to withdraw Schumacher as prior art.

Responsive to paragraph 16 of the office action, the examiner has rejected claims 10, 14-15 and 17 as being anticipated by Muza et al. (US 5397017). Muza has a “snack package” required to be filled by the user with medications – hardly what Applicant's attorney would consider a snack. Further, the bottle of Muza must be supplied by the user and filled with a liquid by the user. Thereafter the meds are removed from the “snack package” allowing the user supplied liquid in the user supplied bottle to be consumed with the meds, hence the title – Pill Dispenser Cap. Again, the cited art does not disclose all three element of Applicant. Applicant is supplying a filled snack package and a filled bottle held together with an ENVELOPE (30). Muza's practitioner must

FILL the cap, supply and fill the bottle and then assemble the two items by screwing the cap onto the bottle. NO ENVELOPE is used to insure the cap will not become unscrewed during transit from the user's place of med storage to the place the user consumes the meds. The examiner has formed the opinion that Muza discloses a catch (Figure 3, Item 32) however applicant's attorney reads item 32 as a threaded portion (page 2, line 42). Muza does teach a projection 46 and mating receptacle 48 (page 3 lines 17-20 but for the purpose of preventing the lid from being inadvertently rotated out of registration in dispensing the meds not to secure the cap to the user supplied bottle. Applicant's attorney respectfully requests the examiner to withdraw MUZA as appropriate prior art.

Responsive to paragraph 17 of the office action, the examiner has rejected claims 10, 14-15 and 17 as being anticipated by Selz (US 4693410). Prior responses by applicant's attorney have extensively discussed Selz and applicant's attorney respectfully requests the examiner to review that discussion. Selz does not have a bottle (10) it must be supplied by the user. Selz does not provide a snack food (20), it must be provided by the user. Selz does not provide an ENVELOPE (30) to hold the user provided bottle (10) to a user provided snack food (20). What Selz does provide is a DRINKING CUP (ITEM 1 in the drawings – nominated by the examiner as an ENVELOPE) (further the CUP is not taught by Selz to be filled with a snack food). Said DRINK CUP is fabricated with a closure for OPEN bottles or cans provided by the user. The examiner appears to have formed the opinion that if the prior art discloses some structure that looks like it could have snack food stuffed into it and said structure is attachable to some bottle it is proper prior art. Applicant's attorney respectfully traverses examiner's opinion. The prior art must reasonably function to perform the activity taught by applicant's invention. The practitioner of Selz must purchase a bottle or can beverage, open the container and may use the Selz CUP to assist in consuming the beverage where after, if not totally consumed the user may use the closure fabricated into the Selz CUP to reseal the bottle or can to maintain the left-over beverage in the container. The teaching of Selz includes alignment of the closure fabricated into the CUP with the open container. Should any obstruction such as a snack food be placed into the CUP said alignment may not be possible and the leftover beverage will leak from the container. The examiner makes may references to snack food however, Selz makes no such references. It appears that examiner is supplying the snack food as an additional item to Selz, therefore applicant's attorney respectfully requests the examiner to withdraw Selz at proper prior art.

Responding to paragraphs 18, 19 and 20 of the office action, examiner has rejected claims 1-2, 6, 10, 14-15 and 17 as being unpatentable over Brauner et.al (US 5372817). Franco (US 5743423).

The examiner asserts that Brauner discloses a drink bottle (Figure 4, item 12). The examiner asserts that Brauner discloses a sealed snack package (Figure 4, item 20). Examiner fails to find an ENVELOPE (30) or the use of the combination to in a vending machine OR applicant's inventive result to add value to the BOTTLED item. The purpose of Brauner is to provide a SAMPLE of a food item contained in the "snack package" to advertise a new product or improved existing product to entice the buyer to seek out the "PRODUCT" off the shelf, elsewhere, and purchase a compete package of the "snack food" – hence the title "CERIAL SAMPER PACAGE". The examiner observes that the Brauner bottle is not cylindrical but attempts to justify this by citing Franco which has a cylindrical bottle to combine with a snap-on package (such as disclosed by Brauner). But Franco ALSO fails to disclose the use of an ENVELOPE (30) to combine the cereal sample to the bottle. The basic elements of applicant's invention are missing from Brauner and Franco therefore applicant's attorney respectfully requests the examiner to withdraw both as prior art.

Responding to paragraph 21 of the office action, the examiner has rejected claim 16 as being unpatentable over Bruner et al. (US5372827) as applied to claims 1-2, 6, 10, 14-15 and 17 as set forth in paragraph 20 of the office action and in further view of Singer (US6085919). As discussed above, Bruner does not disclose all of the elements of applicant's invention. Even in view of Singer which does have a bottle (10) and a snack package (20) but does not disclose an ENVELOPE (30). The "snack package" of Singer, item 414 filled with a prize which may be edible but may also constitute a chocking hazard, hardly a WINNING prize. Hence the title of the invention – BOTTLE CAP WITH PRIZE – the user must provide the contents of the "snack package" 414. No teaching of Singer indicates the use of the Singer combination with a vending machine or adding value to contents of the bottle. Thus, without an ENVELOPE (30) all combinations cited by the examiner continue to lack of ALL of the elements disclosed by applicant. Thus, applicant's attorney respectfully requests examiner to withdraw Singer as proper prior art.

Responsive to paragraph 22 of the office action, the examiner has rejected claims 3-4, 7-8 and 11-12 over Brauner in view of Lemeison (US 3112824). As discussed above, Brauner fails to use all of the elements of the applicant's invention. Combining Brauner with Lemeison does not cure the deficit of elements. Lemeison is similar to Singer above in that it adds a premium to container (page 2, lines 1-3) but does not include using an ENVELOPE (30) to secure the "snack/premium container" to

the bottle. As the combination continues to lack all STRUCTURAL elements of applicant's device, applicant's attorney respectfully requests the examiner to withdraw Lemeison as proper prior art.

Responsive to paragraph 23 of the office action, examiner has rejected claims 5, 9 and 13 over Brauner in view of Lemelson in further view of Turpin (US 3962476) and Akutsu et al (US4779738). Turpin has NO BOTTLE (10), no snack (20) and no envelope (30). Akutsu is an envelope (30) but no teaching as to what it is to cover, contain, combine or other use as applied to a vending machine or adding value to the whatever the envelope (30) contains, if anything. The examiner asserts that Turpin holds a food item but said food item of Turpin must be cooked. Turpin does not provide a self heating container so the user must drag a stove/oven around to use Turpin to practice the consumption of the "snack". Hardly near the teaching of applicant to purchase an item, open it (even by means of a score line) and consume it. Applicant has not advocated using a snack food that requires COOKING to be chosen as the contents of the "snack package". Thus, applicant's attorney respectfully requests examiner to withdraw Turpin and Akutsu as proper prior art.

Responding to paragraph 24 of the office action, examiner has rejected claims 1-2, 6, 10, 14-15 and 17 as being unpatentable over Franco (US 5743423). As discussed above Franco discloses a bottle (10) and a "snack package" (20) but fails to use an ENVELOPE (30) to combine the elements. What the examiner classifies as a "snack package" in Franco is a SNAP-ON package (figure 4, item 10) not a combination which securely attaches the "package" (20) to the bottle (10) so that the combination may be used in a vending machine. The examiner is of the opinion that if the "package" contains something edible, the prior art is appropriate. Franco teaches using salt to fill the "package". Applicant's attorney agrees that salt is the one edible rock known to man but respectfully traverses the examiner's opinion that salt is a snack food. The court in KSR cautions "reasonableness". The missing element of the envelope (30) of Franco (a combination of tequila and a container of salt – page 2, lines 2-7) could be placed into an envelope – such as a limo – to protect the combination. However, prior to use, the user would have to supply the wetted rimmed glass (page 2, line12) to use the combination. (Difficult to protect a glass in a vending machine) AND NO ONE would REASONABLY suggest combining drinking and driving! To use Franco the practitioner need to add a DRIVER. Adding other elements, a wetted glass – (this, of course, includes the kitchen sink) and a driver, is far from being reasonable in comparing the prior art to the combination taught by applicant.

Certainly, both Franco and Singer could be considered appropriate prior art had applicant included in the off the shelf snack list the product CRACKER JACK which actually contains a snack food and a prize. However, placing the box of CRACKER JACK around or over a bottle would take "SOME ADAPTION" and then the combination with the bottle (10) may very well take up substantially more space in the vending machine than the space occupied by the bottle alone and thus not be functional. As no such suggestion is made by applicant, it would be unreasonable for the practitioner of applicant's teaching to attempt to shove a box of CRACKER JACK into a vending machine pigeon hole with a bottle.

The examiner does discuss the dependence of the combination on the size of the bottle. However, the examiner does not discuss the source of the bottle to be from a vending machine but appears to pull the bottle out of a box to be placed on a shelf. The examiner then discusses the limitation of this activity as placing constraints on the SIZE of the combination. This is exactly the point of applicant's invention. The practitioner of applicant's invention (one skilled in the art) knows how to select the size of the "snack envelope" (20) and the ENVELOPE (30) to use with the bottle (10) to be of a practical use in the environment occupied by the combination be it a shelf or a vending machine. As this discussion by the examiner indicates the understanding of the examiner that the application does contain limitations, applicant's attorney respectfully request the examiner to acknowledge that the language used by applicant must be read to incorporate limitations easily understood by one skilled in the art.

The examiner acknowledges that Franco uses frictional engagement, protuberances and means positioned to enable access to a snack food with the understanding that some method is used by one skilled in the art to achieve the combination of a bottle and a snack food container. Applicant also uses methods to combine the bottle and the snack food but teaches using a third element – THE ENVELOPE (30) – all three elements functioning within the limits of the Vending Machine.

Responsive to paragraph 25 of the office action, the examiner has rejected claims 16 as being unpatentable over Franco as applied to claims 1-2, 6, 10, 14-15 and 17 in further view of Singer. As set forth above the container of Singer holds a prize. It is unspecified if the prize is edible or meets the FDA requirements for being non toxic or dangerous as a choking hazard. Further, the combination of Franco and Singer lack the ENVELOPE (30) to hold the combination secure to operate in the environment of a vending machine. This applicant's attorney respectfully requests examiner to withdraw Franco and Singer as appropriate prior art.

Responsive to paragraph 26 of the office action, examiner has rejected claims 3-5, 7-9 and 11-13 as being unpatentable over Franco in view of Wills (US 5743423). Akutsu et al. (US 4779738) is cited as evidence. The examiner finds Franco silent as to an adhesive layer and a score line but contends that the combination of Franco with Wills which uses a score line for tamper resistance is obvious to add and examiner finds it further obvious adhesive layer to the combination of applicant. Whatever the examiner has added, the combination is still missing the NEW AND INVENTIVE ENVELOPE (30) to hold the elements securely in place while being used within the environment of a vending machine as taught by applicant. This applicant's attorney respectfully requests examiner to withdraw FRANCO, WILLS, and AKUTSU as proper prior art.

Responsive to paragraph 27 of the office action, the examiner has rejected claims 11-13 as being unpatentable over Schumacher et al. (US 5465835) in view of Willis (US 4544073). Akutsu et al. (US479738) is cited as evidence that a score line is well known in the art. The examiner is of the opinion that Schumacher teaches securing a second compartment using snap fitting or screw means but is silent in teaching an adhesive strip. The combination of SCHUMACHER, WILLIS and AKUTSU in whatever order continues to lack the use of an ENVELOPE (30) to secure the elements together for use in the environment of a vending machine. As discussed above, applicant's attorney respectfully traverses examiner's opinion that the cited prior art is appropriate and requests the examiner to withdraw said prior art.

Responsive to paragraph 28 of the office action, the examiner has rejected claims 11-13 as being unpatentable over Muza in view of Willis.

The examiner finds Muza as teaching a snap fitting or screw means but silent in teaching an adhesive layer. The examiner uses the teaching of Willis to use an adhesive layer. AGAIN, neither Muza nor Willis teaches the use of an ENVELOPE (30) to secure elements within the environment of a vending machine. Therefore, applicant's attorney respectfully requests examiner to withdraw Muza and Willis as appropriate prior art.

Responsive to paragraph 29 of the office action, the examiner has rejected claims 11-13 as being unpatentable over Selz in view of Willis with Akutsu cited as evidence. As discussed above, nothing in any combination of the above cited prior art teaches the use of an ENVELOPE (30) to secure the elements together within the environment of a vending machine and thus should be withdrawn by the examiner.

Responsive to paragraph 30 of the office action, the examiner has rejected claim 16 as being unpatentable over Muza in view of Singer. As discussed above, the combination continues to lack the use of an ENVELOPE (30) to secure the elements together within the environment of a vending machine and thus should be withdrawn by the examiner.

Responsive to paragraph 31 of the office action, the examiner has rejected claim 16 as being unpatentable over Selz in view of Singer. As discussed above, the combination continues to lack the use of an ENVELOPE (30) to secure the elements together within the environment of a vending machine and thus should be withdrawn by the examiner.

Responsive to paragraphs 32 and 33 of the office action, the examiner has cited applicants co-pending PARENT of this CIP as prior art. Usually the patent office honors applicant's request to abandon the PARENT of a CIP. In this case it appears both the PARENT and the CIP are pending. This is not desired by applicant and applicant seeks assistance of the examiner to remedy the situation to avoid DOUBLE PATENTING.

The solution appears to be complicated by the fact that the two applications are not equivalent. The CIP contains changes to the language in response to examiner's concerns with "adapted", etc. and does not contain claims 1-9 which were recently added to the parent application. These differences need to be resolved. Applicant's attorney is open to suggestions.

Attachment 3 provides an analysis of Examiner Mai's "adapted for" and "enabled for" as not proper as well Examiner Viren Thaker's opinion of Functional VS Structural. Applicant's new attorney respectfully contends that this analysis clearly demonstrates that the original attorney's use of adapted for and enabled for precisely limit and are reasonable use of language to describe applicant's invention. Further, the limits imposed by the language establish structure, especially of the ENVELOPE, as well as the function of the ENVELOPE to keep two items securely engaged. The prior art cited by Examiner Viren Thaker does not disclose an ENVELOPE and thus fails to include the STRUCTURE of applicant's invention. The cited prior art provides the function of attaching two elements together but none teach that the attachment is SECURE enough to be used in the environment of a vending machine as taught by applicant.

Applicant's claims are fully supported by the specification and teach how to combine two or more elements to function within the environment of a vending machine in an inventive manner – to allow the price point for the combination to be adjusted thereby increasing the

earnings of the vending machine without modification of the off-the-shelf vending machine. Applicant's attorney respectfully requests examiner to determine the inventive quality of this application and because this invention is not disclosed by any of the prior art the invention should be allowable.

Upon consideration of the above remarks, the applicant respectfully believes that the application will be found in condition for review and such review for allowance is respectfully solicited.

Respectfully submitted,
/John E. Halamka/

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